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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/712,837	11/10/00	STUDDIFORD R	66033 12 (61

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EXAMINER
BAXTER,G

ART UNIT	PAPER NUMBER
3632	7

DATE MAILED: 10/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/712,837	Michael Dunn et al.
Examiner	**Art Unit**
Gwendolyn Baxter	3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely..
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-6 and 13-30* is/are rejected.

7) ☒ Claim(s) *7-12* is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
18) ☐ Interview Summary (PTO-413) Paper No(s). _____
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

This is the first office action for serial number 09/712,837, Bicycle Accessory Mounting Apparatus, filed on November 10, 2000.

Information Disclosure Statement

The information disclosure statement filed July 12, 2001 has been placed in the application file, and the information referred to therein has been considered.

Claim Rejections - 35 USC § 112

Claims 22-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 22, line 2, recites "wherein said a cinching member". Since the cinching member has not been positively claimed in claim 21, but functionally claimed therein. Therefore, it is unclear if applicant intends to claim a combination of a mounting base and cinching member or a subcombination of the mounting base. If the combination is the intent, then, the language at line 2, "a mounting base slot for receiving a cinching member" should read --a mounting base slot receiving a cinching member--.

In claim 25, line 2, "the fabric strap buckle engagement portion" lacks proper antecedent basis.

In claims 26 and 27, line 1, respectively, "A mounting" should read --The mounting-- to reflect the antecedence found at line 1 of claim 21.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,909,051 to Lee, hereinafter Lee. The present invention reads on Lee as follows: Lee discloses a mounting apparatus comprising a mounting base (10) having a first end and a second end, a mounting base slot (32) having a mounting base left slot opening (near 24) and a mounting base right slot opening (not numbered). The first and second ends of the mounting base having a first and second curved surfaces (20,22), respectively. A cinching member (12,14) is adapted to slide through the slot and secure first and second objects at the mounting base first and second curved portions. The mounting base is disclosed to be elastic which is inherently flexible material.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of U.S. Patent No. 5,278,220 to Vermeire. Lee discloses the limitations of the base claim, including the mounting base being formed of an elastomeric material. However, fails to disclose the specified shore hardness. Vermeire teaches an elastomeric having a shore hardness between 40-85. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted the elastomeric material of the mounting base as taught by Lee to have incorporated polymer composition taught by Vermeire for the purpose of providing a strong apparatus having a retention during aging of tensile strength, color stability and low volatility upon exposure to heat and/or light.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-26 and 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, and 7-9 of U.S. Patent No. 6,195,846. Although the conflicting claims are not identical, they are not patentably distinct from each other. Studdiford '846 discloses a mounting base (14) having a first end (14T) and a second end (14B), and having a mounting base first curved portion (14TC) at the first end. A mounting base second curved surface (14BC) is located at the second end. A mounting base slot (claim 8, lines 2 and 3) for receiving a cinching member there through. The cinching member is adapted to slide through the slot and secure first and second objects at the mounting base first and second curved portions. The cinching member comprises a fabric strap (claim 2) having a fabric strap first hook portion (claim 1, lines 3-5) and a fabric strap first loop portion (claim 1, lines 3-5).

Regarding claim 23, Studdiford '846 fails to disclose a second hook and loop portion. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the strap to have incorporated a second hook and loop portions, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art and to further secure the cinching means. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claims 1-6, 13, 15-20, 24 and 25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 7-9 of U.S. Patent No. 6,195,846 in view of U.S. Patent No. 4,176,770 to Griggs. Studdiford discloses the limitations of the base claim, excluding a fabric strap buckle engagement portion. Griggs disclose

a mounting apparatus having a body (2) and a strap (5). The strap (5) includes a a fabric strap buckle engagement portion (26') and buckle (36). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to have modified the strap as taught by Studdiford to have incorporated the buckle as taught by Griggs for the purpose of facilitating the tightening of the strap for securing the object within the apparatus.

Regarding claims 1-6, 13, 15-17 and 23, Studdiford '846 fails to disclose a second hook and loop portion. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the strap to have incorporated a second hook and loop portions, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art and to further secure the cinching means. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claims 18-20, the mere recitation of bicycle accessories to be held within the mounting apparatus does not show in the invention that it would be critical to the functionality of the device. In fact, the various claimed type of accessories held within the apparatus is considered intended use choices. Consequently, the bicycle accessories of the claimed invention fails to render itself patentably distinguishable over the aforementioned references.

Claim 14 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 7-9 of U.S. Patent No. 6,195,846 in view of Griggs and Vermeire. Studdiford in view of Griggs discloses the limitations of the base claim, excluding the specified range shore hardness. Vermeire teaches an elastomeric having a shore

hardness between 40-85. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted the elastomeric material of the mounting base as taught by Lee to have incorporated polymer composition taught by Vermeire for the purpose of providing a strong apparatus having a retention during aging of tensile strength, color stability and low volatility upon exposure to heat and/or light.

Allowable Subject Matter

Claims 7-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art fails to discloses the actual arrangement of the first and second hook and loop portions along the strap for securing the object.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Bigg 5,451,439 and Hamanaka 5,187,224 teach an elastomeric having a shore hardness between 40-85.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gwendolyn Baxter whose telephone number is (703) 308-0702. The

examiner can normally be reached Monday-Friday from 8:30 A.M. to 5:00 P.M. Eastern Time Zone.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113. The fax phone number for this Group is (703) 305-3597.

Gwendolyn Baxter
September 26, 2001

LESLIE A. BRAUN
SUPERVISORY PATENT EXAMINER